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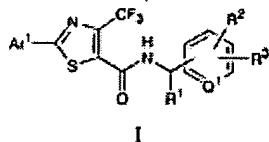
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In re Application of :  
 Kenneth M. Boy et al :  
 Serial No.: 10/731,854 : PETITION DECISION  
 Filed: December 9, 2003 :  
 Attorney Docket No.: CT-2709 NP :

This is in response to the petition under 37 CFR 1.144, filed April 5, 2005, requesting withdrawal or modification of an improper restriction requirement.

## BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained claims numbered 1-17. In a first Office action, mailed July 29, 2004, the examiner set forth a restriction requirement based on Formula I, as follows:



- Group I – instances where Q represents CH;
- Group II – instances where Q represents N;
- Group III – Claims 12-17 drawn to multiple uses.

The examiner reasoned that the compounds (i.e. claims 1-11) are patentably distinct from each other and have different fields of search based on their classification. The examiner also reasoned that the method of use was distinct from the product claims based on different uses and capability to use other products in the claimed method. The examiner further required an election of species for which ever group was elected.

Applicants replied on August 18, 2004, electing Group I with traverse, arguing that the compounds of Groups I and II share a significant structural similarity and should be examined

together and that any search for the compounds would of necessity also be a search for their uses. Applicants also identified a species for examination, as required.

The examiner mailed a new Office action to applicants on October 15, 2004, responding to the traversal by maintaining that the compounds do not share a significant structural similarity and therefore, the restriction is proper. The examiner then noted the species elected and defined a "genus" drawn therefrom which was examined. Claim 1 was rejected under 35 U.S.C. 112, first paragraph, for lack of written description. Claims 2, 5-8 and 10-11 were indicated allowable, but dependent on a rejected claim. All other claims were withdrawn from consideration as non-elected.

Applicants replied on January 5, 2005, by amending claim 1 to limit it to the compounds of Group I and canceling claim 2. Applicants further traversed the restriction requirement by noting that all of the claims had been limited to the compounds of Group I (Q is CH), but that claims 3, 4 and 9 had been withdrawn by the examiner even though they are within the scope of the genus identified in claim 1. The rejection was argued as having been overcome by the amendments. Applicants also requested rejoinder of the method claims.

The examiner mailed a new non-Final Office action to applicants on March 23, 2005, setting a three month shortened statutory period for reply. The examiner responded to the continued traversal of the restriction requirement citing burden on the Office and made the requirement Final. Claim 1 was objected to as containing non-elected subject matter and a requirement made to cancel such subject matter.

This petition was filed April 5, 2005, requesting review of the examiner's procedure following applicants' election and requirement to cancel non-elected inventions.

## DISCUSSION

Applicants request in their petition that the examiner be directed to examine withdrawn claims 3, 4 and 9, to rule that claims 1-2, 5-8 and 10-11, as amended, do not contain non-elected subject matter and to rejoin method claims 12-17. Applicants do not argue the restriction between Groups I and II above in view of the fact that compounds of Group II have been canceled from the claims.

A review of the examiner's actions shows that following election of a species within elected Group I the examiner indicated what the value of most of the variables would be and, in effect, carved from the genus of compounds of claim 1 a subgenus which was indicated to have been examined and found to be allowable over the prior art. The effect of this is that the examiner has determined what applicants' claim scope will be. This is not the examiner's function, but applicants. The examiner's function is to determine whether the scope of the claim as set forth by applicants is patentable. The examiner, by dividing the claims into two Markush groups based on the value of Q in essence determined that all compounds falling within the scope of each Group noted above are related and would be examined together. Use of the election of species tool by the examiner was proper in this instance since the number of compounds within each group is very large and by requiring applicants to elect a species for purposes of initial

examination the burden of the examiner is lessened. However, use of the election of species tool requires an examiner to follow the guidelines set forth in M.P.E.P. 803.02, namely to determine whether the elected species is free of the prior art, as in this instance, and then to expand the examination to a reasonable number of additional species which the examiner has done here. However, it does not permit the examiner to limit applicants' claims to only those species examined (termed by applicants as intraclaim restriction). The section specifically states that when all examined species (i.e. – less than the total number of species present) are found to be free of the prior art, then the genus (as defined in the claim) is considered to be free of the prior art and will be further examined for compliance with respect to all other pertinent sections of the statute. By restricting applicants' claims to the subgenus examined the examiner has failed to follow these guidelines.

With respect to the restriction between Groups I and III, product and method of use of the product, although not argued in the petition, the request for rejoinder was argued in applicants' traversals of the restriction requirement. In accordance with the decision of *In re Ochiai* when product and method of making or method of using a product claims are present, restriction may be appropriate, as here. However, where product claims are elected for prosecution and are found allowable in all respects, rejoinder of method claims having the same scope as the allowable product claims (as here) is required. Any rejoined method claims will then be examined for compliance with all applicable sections of the statute. In view of the examiner's indication of patentability of the product claims (or at least an examined portion thereof) rejoinder of the method claims herein is required.

#### DECISION

The petition is **GRANTED**. In view of this decision, the last Office action is found to be incomplete and is withdrawn.

**The application will be forwarded to the examiner for preparation of a new action on the merits not inconsistent with this decision.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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